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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,834	01/12/2004	Yen-Fu Chen	AUS920030663US1	9834

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EXAMINER
KUMAR, ANIL N

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/755,834	CHEN ET AL.
	Examiner	Art Unit	
	Anil N. Kumar	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>12 January 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-21</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-21</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>1/12/2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/12/2004</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is in response to the original filing of January 12th, 2004. Claims (1-

21) are pending and have been considered below.

Claim Objections

2.   Claim 21 objected to because of the following informalities: "21. The system as

set forth in claim 1.... " Note Claim 1 is a Method and Claim 15 is a System. The

examiner assumes that this is a typographic error and that Claim 21 should have

depended from Claim 15, and will so consider during the prosecution of this application.

Appropriate correction is required.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 1, 8 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 12 and 23 respectively, of copending Application No.10/755831. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examiner contends that a report, whether it is called Monitor Report or Reference Note is still a report. Furthermore, the contents of both the reports are the same source reference data.

This is a _provisional_ obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5.   Claims 2, 9 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 15 and 26 respectively, of copending Application No.10/755831.

This is a _provisional_ obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6.   Claims 3, 10 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 16 and 27 respectively, of copending Application No.10/755831.

       This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7.   Claims 4, 11 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6, 17 and 28 respectively, of copending Application No.10/755831.

       This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8.   Claims 5, 12 and 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 8 and 15 respectively, of copending Application No.10/755831.

       This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9.   Claims 6, 13 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, 18 and 29 respectively, of copending Application No.10/755831.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Jacobson</u> (US 6735701 B1) in view of <u>TechSmith Corp.</u> (SnagIt User's Guide).

Claims 1, 8 and 15: <u>Jacobson</u> discloses a method and system for monitoring activities of a person (...system for monitoring network user compliance... Abstract),

- capturing and recording on a computer readable medium one or more source reference data items corresponding to said selected content (i.e. policy recommendations, including metadata, col 6 lines 23-24);

- automatically generating a reference note containing said recorded source reference data items (i.e. policy compliance and reporting, col 11 lines 7-9 and Fig. 30).

but does not disclose how the content is transferred from one computer resource to another computer resource and other related features. However, <u>TechSmith Corp.</u> discloses a method and a system (SnagIt program on a computer) for transferring content from one computer resource to another computer resource (i.e. "a screen capture process ... gives you the ability to manipulate, alter, save and use the capture of numerous tasks", see p. 2). Furthermore:

- receiving from a user a first insertion point (i.e. a "Send Mail" output options see p. 26) or replacement area from a first user interface (Output Menu, see p. 25) to a destination computer resource (i.e. the email program, see p. 26), said insertion point or replacement area being user-selected (see p. 25 line 3);

- providing a source user interface to a user-selected source computer resource upon user command (i.e. an Image capture, see p. 39-40);

- receiving a user selection of content (i.e. Input Menu, p. 5) to be transferred from said source user interface to said first insertion point or replacement area (i.e. Output Menu, p. 5) ;

- automatically copying said selected content to a transfer buffer (i.e. SnagIt prepares image for different file formats in memory, see p. 29);

Therefore, it would have been obvious to one having ordinary skill in the art at the time of this invention to provide the transferring content from one resource to another (i.e. copying images from web page to local storage, etc...), in <u>Jacobson.</u>

One would be motivated to provide this feature to improve productivity of network

users.

Claims 2, 9 and 16: Jacobson and TechSmith Corp. disclose a method, system

and media for monitoring activities of a person transferring content from one

computer resource to another computer resource, as in claims 1, 8 and 15

above. Furthermore, TechSmith Corp. discloses capturing a source identifier

selected from the group of a file name, a path name, a folder name, a server

name, a Uniform Resource Locator, and a network address. (i.e. DirectX: select

automatic file name... p. 22). Therefore, it would have been obvious to one

having ordinary skill in the art at the time of this invention to provide automatic

capture of metadata of the content, in Jacobson. One would be motivated to

provide this feature, automatically capture metadata of any content transfer, to

users and administrators to improve their productivity.

Claims 3, 10 and 17: Jacobson and TechSmith Corp. disclose a method, system

and media for monitoring activities of a person transferring content from one

computer resource to another computer resource, as in claims 1, 8 and 15

above. Furthermore, TechSmith Corp. discloses capturing a system time, a

system date, or both a system time and date (i.e. ...to include the time and

date... p. 31). Therefore, it would have been obvious to one having ordinary skill

in the art at the time of this invention to provide automatic capture of system time

and date, in <u>Jacobson.</u> One would be motivated to provide this feature to help users and administrators to document (time stamp) content transfers by network users.

Claims 4, 11 and 18: <u>Jacobson</u> and <u>TechSmith Corp.</u> disclose a method, system and media for monitoring activities of a person transferring content from one computer resource to another computer resource, as in claims 1, 8 and 15 above. Furthermore, <u>TechSmith Corp.</u> discloses capturing an author identifier (i.e. ...to include ... other system data... p. 31). Therefore, it would have been obvious to one having ordinary skill in the art at the time of this invention to provide automatic capture of author identity, in <u>Jacobson.</u> One would be motivated to provide this feature to help users and administrators to monitor and analyze content transfers by network users.

Claim 5, 12 and 19: <u>Jacobson</u> and <u>TechSmith Corp.</u> disclose a method, system and media for monitoring activities of a person transferring content from one computer resource to another computer resource, as in claim 1, 8, 15 above. Furthermore, <u>Jacobson</u> discloses a method for capturing user identifier (i.e. ... notifying a network user..., col 2 lines 20-24).

Claims 6, 13 and 20: <u>Jacobson</u> and <u>TechSmith Corp.</u> disclose a method, system and media for monitoring activities of a person transferring content from one

computer resource to another computer resource, as in claims 1, 8 and 15

above. Furthermore, <u>TechSmith Corp.</u> discloses capturing a publication date (i.e.

...to include ... other system data... p. 31). Therefore, it would have been

obvious to one having ordinary skill in the art at the time of this invention to

provide automatic capture of publication date, in <u>Jacobson.</u> One would be

motivated to provide this feature to help users and administrators to monitor and

analyze content transfers by network users.

Claim 7, 14 and 21: <u>Jacobson</u> and <u>TechSmith Corp.</u> disclose a method, system

and media for monitoring activities of a person transferring content from one

computer resource to another computer resource, as in claim 1, 8, 15 above.

Furthermore, <u>Jacobson</u> discloses a method for ...generating a note selected form

a group ... (i.e. ... collects information on documents in the system..., col 11

lines 27-34 and Fig. 5).

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

    a. <u>Berstis</u> et al. (US 2005/0155017 A1) discloses a system and method for

       automatic natural language translation during information transfer

b. <u>Chen</u> et al. (US 2004/0250215 A1) discloses a system and method for

content transfer between program entities

c. <u>Dornbush</u> et al. (US 6,773,266 B1) discloses a method for implementing

collaborative training and online learning over a computer network and related

techniques

d. <u>Ginter</u> et al. (US 2006/0224903 A1) discloses a system and methods for

secure transaction management and electronics rights protection

e. <u>Maggio</u> (US 2006/0282319 A1) discloses a method and system for

substituting media content

f. <u>Maggio</u> et al. (US 2006/0253330 A1) discloses a method and system for

automatically substituting media content

g. <u>Orchier</u> et al. (US 6,070,244) discloses a computer network security

management system

h. <u>Spagna</u> et al. (US 6,587,837 B1) discloses a method for delivering electronic

content from an online store

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Anil N. Kumar whose telephone number is (571) 270-

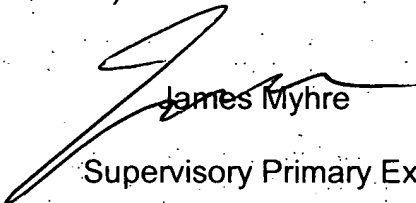1693. The examiner can normally be reached on Mon-Fri EST (Alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Myhre can be reached on (571) 272-6722. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ANK   James Myhre

1/18/2007   Supervisory Primary Examiner